

## **REMARKS AND ARGUMENTS**

### **I. General Remarks**

At page 3 of the Office action, the Examiner requested that Applicant include the status of pending applications from which the instant application claims its priority. In response, Applicant amends herein the first sentence of the specification by incorporating the status for each of the patent applications from which the instant application claims its priority.

At page 2 of the Office action, the Examiner stated that the status of claims 2, 4, 6, 7, 8, 13, 14, 19, 20, 25, 26, 29, 51, 57, 69, 71, 72, 75, 76, 78, 79, , 82, 83, 85, 86, 89, 93, 94, 98, 99, 100, 101, 102, 103, 104, 105, 106, 107, 110, 112, and 113 should be listed as previously presented. In accordance with revised 37 CFR 1.121, the status of the above-listed claims has been listed as previously presented herein.

In accordance with the Examiner's request at page 2 of the Office action, Claim 85 is amended to correct a typographical error by replacing "dimmer" with "dimer."

### **II. Patentability Arguments**

#### **A. The Objections to Claims 85 and 113 Should Be Withdrawn**

At page 3 of the Office action, the Examiner objected to claim 85 and requested correction of a typographical error in that claim. The error is corrected in this response by amending the claim to replace the word "dimmer" with the word "dimer." Therefore, the objection to claim 85 should be withdrawn and withdrawal is requested.

At page 4 of the Office action, the Examiner objected to claim 113 because of the grammatically incorrect phrase “treating inhibiting.” The claim 113 is amended herein by deleting the word “treating,” therefore the objection to claim 113 should be withdrawn and withdrawal is requested.

B. The Rejections Under 35 U.S.C. §112, First Paragraph, Should Be Withdrawn

At page 4 of the Office action, the Examiner rejected claims 85 and 89 under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Examiner states that “the specification, while being enabling for making and using an effective amount of a composition selected from the group consisting of DNA dinucleotides and DNA dimers in the claimed method, does not reasonably provide enablement for making and using other dinucleotide or dimer in the claimed method.” In response, claims 85 and 89 are amended herein by inserting the term “DNA” before the word “dinucleotides” and before the word “dinucleotide.” In view of the amendment, Applicant submits that the rejection under 35 U.S.C. § 112, first paragraph, should be withdrawn and withdrawal is requested.

C. The Rejections Under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

The Examiner rejected claims 7 and 14 (page 8 of the Office action), claims 71 and 93 (page 9 of the Office action) and claim 110 (page 10 of the Office action) allegedly as being incomplete for omitting an element. The Examiner suggested correction of the omission by adding a phrase “of a mammal.”

In response, Applicant amends herein claims 7, 14, 71, 93 and 110 by adding the phrase “of a mammal,” therefore the rejection under 35 U.S.C. § 112, second paragraph, to claims 7, 14, 71, 93, 110 and their dependent claims should be withdrawn and withdrawal is requested.

At page 9 of the Office action, the Examiner rejected claims 51, 57, 69, 106 and 107 because of alleged insufficient antecedent basis for the element “said oligonucleotides” in the claims. In response, Applicants amends claims 51, 57, 69, 106 and 107 by reciting “said **oligonucleotide.**” Applicants respectfully submit that amended claims 51, 57, 69 and 106 have proper antecedent basis for the element “said oligonucleotide” and therefore the rejection to claims 51, 57, 69, 106 and their dependent claims under 35 U.S.C. § 112, second paragraph should be withdrawn and withdrawal is requested.

D. The Provisional Obviousness-Type Double Patenting Rejection Should Be Withdrawn

At page 10 of the Office action, the Examiner rejected claims 1-11, 13-17, 19, 20, 23, 25, 26, 29, 32, 51, 52, 57, 58, 69, 71, 72, 75-79, 81-83, 85, 86, 88, 89, 93-95, 98-107 and 110-113 over claims 1-63 of co-owned pending application 10/122,633 under the judicially created doctrine of obviousness-type double patenting.

In response, Applicant files herewith a terminal disclaimer over copending application 10/122,633 in compliance with 37 CFR 1.321(c) to obviate the provisional obviousness-type double patenting rejection. Therefore the rejection may be properly withdrawn and the withdrawal is requested.

**Conclusion**

Applicants respectfully submit that the claims are in condition for allowance and early notification thereof is requested. If in the interest of expediting prosecution, the Examiner has questions or comments he is invited to telephone the undersigned at the indicated telephone number.

Respectfully submitted,

HOWREY SIMON ARNOLD & WHITE, LLP

By: 

David W. Clough, Ph.D.  
Registration No.: 36,107

Dated: June 21, 2004  
321 N. Clark Street, Suite 3400  
Chicago, IL 60610  
Telephone: (312) 595-1408  
Fax: (312) 595-2250